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OFFICE OF PETITIONS

In re Application
Arthur M. Krieg et al.
Application No. 10/613,524
Filed: July 3, 2003
Attorney Docket No.
C1037.70042US00

: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705 filed April 27, 2009. Applicant requests that the determination of patent term adjustment be corrected from 752 days to 1254 days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

To the extent that this application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment

and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

With respect to the over 3 year calculation, rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.

To the extent that applicant otherwise requests correction of the patent term adjustment at the time of the mailing of the Notice of Allowance, the application for patent term adjustment is **GRANTED**.

The Office has updated the PALM screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is six hundred seventy eight (**678**) days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On January 27, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 752 days. The instant application for patent term adjustment was timely filed¹ on or before payment of the issue fee.

With respect to the patent term adjustment at the time of the mailing of the notice of allowance, applicants acknowledge the period of adjustment of 941 days for Office delay.

Applicants argue that following the submission of the RCE on October 30, 2008, Applicant filed a series of Information Disclosure Statements on December 10, 2008, December 22, 2008 and on January 12, 2009, resulting in delays of 41 days (period from 10/31/2008 to 12/10/2008), 53 days (period from 10/31/2008 to 12/22/2008), and 74 days (period from 10/31/2008 to 01/12/2009) for applicant delay. See 37 CFR § 1.704(c)(8).

¹ PALM records indicate that the issue fee was paid on April 27, 2009.

Applicant's argument is persuasive. A period of reduction should be entered for the Information Disclosure Statements (IDS) filed December 10, 2008, December 22, 2008 and January 12, 2009. The period of reduction pursuant to 37 CFR 1.704(c)(8) for filing the IDSs without a 1.704(d) statement after the request for continued examination is 74 days, counting the number of days in the period beginning on the day after the initial reply (the RCE) was filed, October 31, 2008 and ending on the date of filing of the last supplemental paper, the IDS filed January 12, 2009. Accordingly, a period of reduction of 74 days is being entered.

It is noted that under the circumstances entry of a period of reduction for the filing of the interview summary filed January 20, 2009 is not warranted.

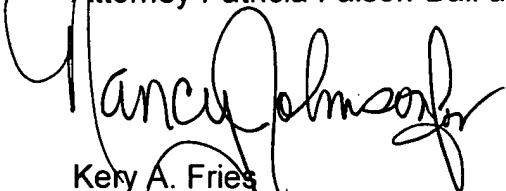
In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is six hundred seventy-eight (678) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.


Karen A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Examination Policy

Enclosure: Copy of Revised PALM Screen

PALM INTRANET

PTA Calculations for Application: 10/613524					
Application Filing Date:		07/03/2003	PTO Delay (PTO):		941
Issue Date of Patent:			Three Years:		0
Pre-Issue Petitions:		0	Applicant Delay (APPL):		189
Post-Issue Petitions:		0	Total PTA (days):		678
PTO Delay Adjustment:		-74			

File Contents History					
Number	Date	Contents Description	PTO	APPL	START
94	09/17/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		74	
81	01/27/2009	MAIL NOTICE OF ALLOWANCE			
80	01/22/2009	ISSUE REVISION COMPLETED			
79	01/22/2009	DOCUMENT VERIFICATION			
78	01/21/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
77	01/21/2009	CASE DOCKETED TO EXAMINER IN GAU			
76	01/21/2009	EXAMINER'S AMENDMENT COMMUNICATION			
75	01/21/2009	NOTICE OF ALLOWABILITY			
74	01/12/2009	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
73	12/22/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
72	12/10/2008	REFERENCE CAPTURE ON IDS			
71	12/10/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
70	12/22/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
69	12/10/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
68	12/22/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
67	12/10/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
66	11/17/2008	DATE FORWARDED TO EXAMINER			
65	10/30/2008	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
64	11/17/2008	DATE FORWARDED TO EXAMINER			

63	10/30/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)		92	59
62	11/17/2008	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
61	10/30/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
60	10/30/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
59	04/30/2008	MAIL FINAL REJECTION (PTOL - 326)			
58	04/28/2008	FINAL REJECTION			
57	02/12/2008	DATE FORWARDED TO EXAMINER			
56	01/02/2008	RESPONSE AFTER NON-FINAL ACTION		97	54
55	01/02/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
54	06/27/2007	MAIL NON-FINAL REJECTION			
53	06/11/2007	NON-FINAL REJECTION			
52	04/29/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
51	10/27/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
50	03/21/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
49	12/08/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
48	05/18/2007	DATE FORWARDED TO EXAMINER			
47	05/07/2007	RESPONSE TO ELECTION / RESTRICTION FILED			
46	04/02/2007	MAIL RESTRICTION REQUIREMENT	941		-1
45	03/29/2007	REQUIREMENT FOR RESTRICTION / ELECTION			
44	12/08/2006	REFERENCE CAPTURE ON IDS			
43.7	12/08/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
43	12/08/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
42	11/01/2006	MISCELLANEOUS INCOMING LETTER			
41	07/27/2006	PRELIMINARY AMENDMENT			
40	08/01/2006	ERROR(S) IN CRF CORRECTED BY STIC			
39	06/22/2006	MAIL LETTER REQUIRING CRF (UNREADABLE, NON-COMPLIANT, NOT SUBMITTED)			
38	06/20/2006	CRF DISKETTE UNREADABLE / DID NOT COMPLY / REQUIRED BUT NOT SUBMITTED			
37	06/15/2006	CASE DOCKETED TO EXAMINER IN GAU			

36	04/05/2006	CASE DOCKETED TO EXAMINER IN GAU		
35	12/01/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE		
34.7	03/21/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
34	03/21/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
33	10/27/2004	REFERENCE CAPTURE ON IDS		
32.7	10/27/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
32	10/27/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
31	08/31/2004	CASE DOCKETED TO EXAMINER IN GAU		
30	04/29/2004	REFERENCE CAPTURE ON IDS		
29.7	04/29/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
29	04/29/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
28	06/25/2004	RECEIPT OF ALL ACKNOWLEDGEMENT LETTERS		
27	04/29/2004	NEW OR ADDITIONAL DRAWING FILED		
26	05/03/2004	RECEIPT OF ACKNOWLEDGMENT LETTER		
25	01/27/2004	APPLICATION RETURN FROM OIPE		
24	01/27/2004	APPLICATION RETURN TO OIPE		
23	01/27/2004	APPLICATION DISPATCHED FROM OIPE		
22	01/28/2004	APPLICATION IS NOW COMPLETE		
21	01/12/2004	PAYMENT OF ADDITIONAL FILING FEE/PREEEXAM		
19	07/03/2003	CLAIM PRELIMINARY AMENDMENT		
17	01/12/2004	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC		
16	11/12/2003	RECEIPT OF ACKNOWLEDGMENT LETTER		
15	11/12/2003	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED		
12	10/27/2003	AGENCY REFERRAL LETTER MAILED		
11	10/09/2003	AGENCY REFERRAL LETTER MAILED		
10	10/09/2003	AGENCY REFERRAL LETTER MAILED		
9	10/08/2003	REFERRED BY L&R FOR THIRD-LEVEL SECURITY REVIEW. AGENCY REFERRAL LETTER GENERATED		

8	10/08/2003	REFERRED BY L&R FOR THIRD-LEVEL SECURITY REVIEW. AGENCY REFERRAL LETTER GENERATED			
7	10/08/2003	REFERRED BY L&R FOR THIRD-LEVEL SECURITY REVIEW. AGENCY REFERRAL LETTER GENERATED			
6	10/07/2003	CASE CLASSIFIED BY OIPE			
5	10/07/2003	REFERRED TO LEVEL 2 (LARS) BY OIPE CSR			
4	08/12/2003	IFW SCAN & PACR AUTO SECURITY REVIEW			
3	08/06/2003	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
2	07/03/2003	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
1	07/03/2003	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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